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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/592,791	06/13/2000	Keita Watanabe	3542-0104P	7997

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EXAMINER

FAULK, DEVONA E

ART UNIT PAPER NUMBER

2644

DATE MAILED: 06/18/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/592,791

Applicant(s)

WATANABE, KEITA

Examiner

Devona E. Faulk

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☒ Claim(s) 8-10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed on 4/7/04, in Paper No. 5, regarding claim 1 on pages 5-7 have been fully considered but they are not persuasive.

Regarding claim 1, the applicant asserts, on page 6, lines 5-13, that the Fujiuchi et al reference does not teach of a battery mounted on an outside of the case so as to be exposed. The examiner agrees, however, the applicant's specification does not disclose that the battery is mounted on an outside of the case so as to be exposed. The applicant's specification only discloses that the "battery is mounted in the case", page 2, line 24 ; "the battery is attached on the case", page 4, line 1; and "the battery is attached to the case of the sound generation", page 5, lines 20-21. Therefore, the amended language regarding the battery exposed on an outside of the case so as to be exposed is considered new matter by the examiner. Therefore, the rejections are maintained.

2. The indicated allowability of claim 2 if rewritten in independent form is withdrawn in view of the newly discovered reference(s) to Isurushi (U.S. Patent 3,858,389). A rejection based on the newly cited reference(s) follows.

3. The indicated allowability of claims 3 and 7 if rewritten in independent form is withdrawn. Claim 3 is withdrawn due to an oversight of the examiner. The Fujiuchi references reads on the claimed matter and a rejection for claim 3 should have been present in the first office action. The examiner mistakenly failed to write up the rejection. Upon further investigation, the examiner has determined that the Fujiuchi reference reads on the claim language presented in claim 7 as well. Rejections for claims 3 and 7 follows.

Claim Rejections - 35 USC § 112

4. Claim 1 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The applicant's specification only discloses that the "battery is mounted in the case", page 2, line 24; "the battery is attached on the case", page 4, line 1; and "the battery is attached to the case of the sound generation", page 5, lines 20-21. Therefore, the amended language regarding the battery exposed on an outside of the case so as to be exposed is considered new matter by the examiner.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. **Claims 1, 3-10** are rejected under 35 U.S.C. 102(b) as being anticipated Fujiuchi et al. (US Patent 5,844,484).

Regarding **claim 1**, Fujiuchi discloses a theft preventive apparatus having an alarm output device comprising a speaker housing (32; Figure 2) which reads on "a case"; a piezoelectric buzzer (21a; Figure 2) which reads on "a sound generating device mounted in the

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case”; a battery (V; Figure 3) mounted on the terminal unit (33), the bottom part of speaker housing, which reads on “a battery mounted on the case”; terminals (33a and 33b; Figure 8) located on the back of the terminal unit (column 8, lines 26-31), which reads on terminals provides on the case”; and terminal (31, column 7, lines 45-49) for plus electrode connection of battery V and terminal (33c; Figure 8) for minus electrode connections of battery V, which reads on “which read on a pair of leads connecting a pair of electrodes of the battery with the terminals”

Claim 3 claims the sound generator of claim 1 wherein each of the leads comprises a contact plate contacted with the corresponding electrode. Fujiuchi teaches of and terminal (31, column 7, lines 45-49) for plus electrode connection of battery V and terminal (33c; Figure 8) for minus electrode connections of battery V. An electrode inherently is held in contact with a metallic plate through which electrons arrive from the external circuit.

Claim 4 claims the sound generator of claim 1 wherein the sound-generating device is a buzzer. Fujiuchi teaches of a piezoelectric buzzer, which reads on “wherein the sound generating device is a buzzer. Thus all elements of claim 4 are comprehended by claim 1.

Claim 5 claims the sound generator of claim 1 wherein the battery is a disc type battery, and has an upper electrode and lower electrode. As stated above in apropos of claim 1, Hughes meets all elements of that claim. Regarding claim 5, Fujiuchi further teaches of the battery (V) being a flat battery or button type battery, (column 6, line 22) and teaches of the battery having a minus and a plus electrode (column 7, line 47; column 8, line 28) which reads on “the battery is a disc type battery, and has an upper electrode lower electrode”.

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Claim 6 claims the sound generator of claim 1 wherein the terminals comprises a pair of terminals for applying a voltage of a battery to a control circuit, and a pair of terminals for applying a voltage from the control circuit to the buzzer for operating it. Regarding claim 6, Fujiuchi teaches that the battery will supply power to the respective circuits in the box (2) (column 6, line22). Terminals (31 and 33c) are for plus and minus electrode connections of battery V. These features read on “a pair of terminals for applying a voltage of a battery to a control circuit”. Terminals (33a and 33b) are connected to the plus and minus electrodes of the piezoelectric buzzer which reads on “ a pair of terminals for applying a voltage from the control circuit to the buzzer for operating it”.

Claim 7 claims the sound generator according to claim 5 wherein the contact plate contacted with the upper electrode is made of a resilient metal plate. Fujiuchi teaches of a positive and negative electrode. An electrode inherently is held in contact with a metallic plate through which electrons arrive from the external circuit. Resilient is defined as capable of withstanding stress without injury. It is interpreted by the examiner that the terminal unit is resilient.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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9. **Claim 2** is rejected under 35 U.S.C. 103(a) as being unpatentable over Fujiuchi et al. (US Patent 5,844,484) in view of Isurushi (U.S. Patent 3,858,389).

Claim 2 claims the sound generator of claim 2 wherein the case has a recess on an outside wall thereof, and the sound-generating device is mounted in the recess. As stated above apropos of claim 1, Fujiuchi meets all elements of that claim. Therefore, Fujiuchi meets all elements of claim 2 with the exception of the claimed matter. Isurushi teaches of a buzzer (9) mounted in a recess on an outside wall of a watch-case (1) (Figure 1). Thus it would have been obvious to one of ordinary skill in the art at the time of the invention to use Isurushi concept of mounting the sound-generating device for the benefit of more effectively transmitting sound.

Claim Objections

10. **Claims 8-10** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Devona E. Faulk whose telephone number is 703-305-4359. The examiner can normally be reached on 8 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Forester W. Isen can be reached on 703-305-4386. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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PRIMARY EXAMINER